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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,848	02/05/2004	John M. Barrie	IPARA-08769	5758

7590 07/16/2007
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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

MAIL DATE	DELIVERY MODE
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07/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/772,848	Applicant(s) BARRIE ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the amendment filed on 12/22/2006.
2. Applicant has canceled claims 4 and 13
3. Claims 1-3 and 5-12 are pending in the case, claims 1 and 7 are independent claims.
4. Acknowledgement is made to the applicant's submission of amendments to the specification and new drawings, filed on 12/22/2006.
5. Applicant has amended the specification in response to the objections cited by the examiner in the *Drawings* and *Specification* sections of the previous office action (dated 4/6/2006). Applicant's amendment has addressed the objections previously made, and therefore, in view of the amendment, objections to the drawings and specification are withdrawn.
6. Examiner's rejection of claims 4 and 13, made under 35 USC 102, as being anticipated by Shanahan as recited in the previous office action (dated 4/6/2006) are withdrawn in view of the cancelled claims.

Priority

7. As previously noted, applicant's claim for domestic priority under 35 U.S.C. 119(e) of US provisional application 60/447,379, filed 2/13/2003 is acknowledged.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

9. Claims 1-3 and 5-12 remain rejected under 35 U.S.C. 102(e) as being anticipated by Shanahan et al. US Patent Publication 2005/0022114, filed 12/5/2001, published 1/27/2005 (hereinafter Shanahan).

10. **Regarding independent claims 1 and 7**, Shanahan discloses receiving a document over an electronic communication network. Shanahan recites: *"In one operational embodiment, multifunctional (i.e., fax, scan, print, store, email) device 512 scans in a document 614"* (paragraph 179). Shanahan discloses the multifunctional device 512 as part of an electronic communication network in Figure 5, reference sign 516 (shown as "Intranet"). Shanahan discloses converting the unformatted document into a formatted document. Shanahan recites: *"document content is detected and converted to a digital form"* (paragraph 179). Shanahan discloses permitting a user to add contextual markups to the formatted document to generate a markup document. Shanahan recites: *"Annotate" is used herein to mean to create a reference between an entity in a document, or region of a document, and some set of links, text segment, images, or embedded data"* (paragraph 117) and *"Document "mark-up" is used herein to mean the annotation applied to a document"* (paragraph 120). Shanahan discloses displaying the mark-up document. Shanahan recites: *"a visualization and interaction system that allows various levels of display and interaction of metadata-enhanced documents"* (paragraph 146).
11. **Regarding dependent claims 2, 8, 9 and 11**, Shanahan discloses the document as an image file (claims 2 and 11) as a manuscript (claim 8) and an educational assignment (claim 9). Shanahan recites: *"A "document" is used herein to mean an electronic (e.g., digital) or physical (e.g., paper) recording of information. In its electronic form, a document may include image data,*

audio data, or video data. Image data may include text, graphics, or bitmaps" (paragraph 119) and *"continuous-education document service request. For example, a textbook document"* (paragraph 145)

12. **Regarding dependent claims 3 and 12**, Shanahan discloses the contextual markups are added to an invisible image that maps to said image file. Shanahan recites: *"A meta-document 100, for example, may be given a personality 104 that is: ... (c) private: marked to keep the document's metadata invisible to other documents"* (paragraph 149).
13. **Regarding dependent claim 5**, Shanahan discloses storing information related to the document in a database. Shanahan recites: *"FIG. 45 is a flow diagram for creating and updating an entity database dynamically from the document information space"* (paragraph 59).
14. **Regarding dependent claim 6**, Shanahan discloses the information consisting of an identifier of a submitter. Shanahan recites: *"this invention relates to the use of a digitally readable personality identifier in a meta-document management system"* (paragraph 3).
15. **Regarding dependent claim 10**, Shanahan discloses the Internet in Figure 2 at reference sign 221.

Response to Arguments

16. Applicant's arguments filed 12/22/2007 have been fully considered but they are not persuasive.
17. Regarding the stated rejection of claim 1, applicant argues: "*Shanahan does not perform this conversion step of converting existing electronic documents to a standardized electronic document format*" (page 6, second paragraph, of the response filed 12/22/2006). Applicant is directed to the rejection of claim, as restated above. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*converting existing electronic documents to a standardized electronic document format*") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
18. Regarding the stated rejection of claim 1, applicant argues: "*The plain meaning of annotate should instead be applied where, for example, contextual markups are described as including editorial comments, corrections, annotations, comments etc.*" (page 6, last paragraph, of the response filed 12/22/2006). Applicant is directed to the rejection of claim, as restated above. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features

upon which applicant relies (i.e., that “*annotate*” means “*editorial comments, corrections, annotations, comments etc.*”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone

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number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Gregory J. Vaughn/
Patent Examiner
July 6, 2007


STEPHEN HONG
SUPERVISORY PATENT EXAMINER